IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Tustin et al.

Serial No.: 10/650,510 Group Art Unit: 1755

Filed: August 28, 2003 Examiner: Patricia L. Hailey

For: FLUIDIZABLE CARBON CATALYSTS

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF AMENDED APPEAL BRIEF

In response to the Notification of Non-Compliant Appeal Brief mailed on December 14, 2006, Appellents submit herewith an amended Appeal Brief in connection with the above-identified application. Appellants have amended the Appeal Brief to include an Evidence appendix (Appendix B) and a Related Proceedings appendix (Appendix C) as requested in the Notification and required under 37 CFR §41.37. The amended brief is being submitted with one month or thirty days of the mailing date of the Notification. Appellants believe that the amended brief overcomes the reasons for non-compliance that were stated in the notification and respectfully request timely consideration of their appeal.

Respectfully submitted,

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December 21, 2006 Date Amendment under 37 CFR 1.111 Kozo SHIMIZU et al.

U.S. Patent Application S.N. 09731,726 Attorney Docket No. 001616

et al. disclose the invention except for the "alpha ray in Sn". Applicants assert that none of the references discloses the compositional limitations on Ag and Sn recited in claims 1 and 4.

In the case of Koslowski et al., Matsumoto et al., and Arai et al., the limitations of claims 1 and 4 are narrower than the broad ranges disclosed. In Koslowski et al., for example, the composition contains 0.1 to 20% Ag, Au or Pt, and 75 to 99.7% Sn. In Masumoto et al., the alloy contains 95 to 99.4% Sn and 0.5 to 3.5% Ag. In Arai et al., a Sn-Ag-Cu alloy is disclosed, with Ag at 2 to 9% and Cu at 2 to 11%. None of these is a disclosure of the recited ranges.

With regard to Ogashiwa et al., the recited limitations of claims 1 and 4 fall within the disclosed broad ranges of the reference only when Ag is selected rather than In, and when the Pb, disclosed as 0-70%, is limited to less than about 8% (if the Ni/Fe content is 0.02%). Moreover, none of Ogashiwa's examples is consistent with the compositional limitations of the claims. For example, none of Ogashiwa's examples shows the limitation of 1.5 to 2.8 wt% Ag.

Therefore, the references do not teach the compositional limitations of claims 1 and 4, and Applicants further argue that the broad compositional disclosures in the references do not suggest the ranges recited in the claims.

As the Examiner has noted, Kozlowski et al. (PL 115725), Matsumoto et al. (JP2000015476), Arai et al. (1999 article), and Ogashiwa et al. (U.S. Pat. No. 6,160,224) do not disclose the limitation of claims 1 and 4 regarding the amount of α -rays in Sn. Applicants respectfully disagree with the Examiner that Akamatsu (JP'427) suggests this limitation of the claims.

Applicants note that the abstract of Akamatsu appears to suggest only using an alloy of Sn and an element of atomic number smaller than 81 and "not related with alpha decay", which

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Applicants interpret to mean "not capable of undergoing alpha decay." The only example given in the abstract is Sn and Bi. There is no disclosure in the abstract of using Ag, and no compositional limitations are disclosed. The Akamatsu et al. Abstract does not specifically disclose use of Sn with reduced α -ray emission. In addition, no quantitative alpha ray emission limitations appear in the provided abstract of the reference.

Applicants understanding of Akamatsu's (JP'427) Table 1 is that some Sn-Ag based are disclosed, but none of the examples in this table is consistent in composition with the limitations on Ag (1.8 to 2.8 wt%) and Sn (90 wt% or more) recited in claims 1 and 4.

Most significantly, most of the entries in Table 1 of JP'427 list a value of alpha emission of "<0.1 cph/cm²", while claims 1 and 4 recite a limitation of 0.01 (cph/cm²) or less. The limitation in the claims is therefore narrower than the values disclosed in the reference by an order of magnitude.

Applicants are unaware of any suggestion in the reference for the value recited in claims 1 and 4.

Applicants therefore believe that there is no suggestion in any of the references for the specific limitation of the claims, and that no *prima facie* case of obviousness can be made using these references. Applicants assert that claims 1-6 are novel and non-obvious over PL 115725 (Kozlowski et al.), JP2000015476 (Matsumoto et al.), Arai et al. (1999 article), Ogashiwa et al. (U.S. Pat. No. 6,160,224) and JP 409260427 (Akamatsu et al.), taken separately or in combination.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned Agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully Submitted,

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